

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAKI UENO, HIDEYASU NAGAI, HOICHI SUZUKI,
TOMOKI FUKAGAWA, and FUMINORI HIKAMI

MAILED

AUG 20 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0594
Application No. 09/479,267

ON BRIEF

Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon a review of the file record of this application, we determine that this appeal is not ripe for decision at this time. Accordingly, we *remand* this application to the jurisdiction of the examiner to take action consistent with the following remarks.

Appeal No. 2003-0594
Application No. 09/479,267

The examiner finally rejected claims 1 through 4 under 35 U.S.C. § 102(e) as anticipated by Aoshima¹, with Iwasaki² cited for "definitional purposes only" (final Office action dated Jun. 8, 2001, Paper No. 6, pages 2 and 4). Appellants subsequently filed a timely Notice of Appeal dated Aug. 9, 2001, Paper No. 9, and an Appeal Brief dated Jan. 16, 2002, Paper No. 11.

In response to appellants' Brief of Jan. 16, 2002, the examiner reopened prosecution in a non-final Office action dated Apr. 3, 2002, Paper No. 12. In this non-final Office action, the examiner made two new rejections. Claims 1-4 were rejected under 35 U.S.C. § 103(a) over Aoshima in view of Iwasaki (Paper No. 12, page 3) and claims 1-4 were rejected under 35 U.S.C. § 103(a) over Aoshima alone (Paper No. 12, page 4).

Appellants submitted a Supplemental Appeal Brief dated Jun. 27, 2002, Paper No. 13, where appellants requested reinstatement of the appeal (page 1) and presented arguments against the rejection of claims 1-4 under 35 U.S.C. § 103(a) over Aoshima in view of Iwasaki (pages 2-6). Appellants failed to recognize or respond to

¹Aoshima et al. (Aoshima), U.S. Patent No. 6,046,892, issued Apr. 4, 2000 and filed on Mar. 17, 1998.

²Iwasaki et al. (Iwasaki), U.S. Patent No. 6,157,525, issued Dec. 5, 2000 and filed on Jun. 29, 1999.

Appeal No. 2003-0594
Application No. 09/479,267

the rejection of claims 1-4 under 35 U.S.C. § 103(a) over Aoshima alone (Paper No. 13, page 2). In the Answer, the examiner merely repeated the two pending rejections from the non-final Office action (Answer dated Sep. 9, 2002, Paper No. 16, pages 3 and 5).

It is clear from 37 CFR § 1.192(d) (1997) that appellants are to be notified by the examiner whenever the Brief does not comply with any of the requirements of 37 CFR § 1.192(c) (2000), and especially where appellants have failed to respond to a ground of rejection, in order to avoid dismissal of the appeal for inadvertent non-compliance with the rule by appellants with respect to one or more grounds of rejection. See *Manual of Patent Examining Procedure (MPEP)*, §§ 1206 and 1215.04, pages 1200-8 through 1200-15 and 1200-40 and 1200-41, 8th ed., Aug. 2001.

Accordingly, we remand this application to the jurisdiction of the examiner to notify appellants that they must correct the defect of not addressing the ground of rejection based on 35 U.S.C. § 103(a) over Aoshima alone by filing a brief (in triplicate) in compliance with 37 CFR § 1.192(c), with a period of one month within which to file the amended brief. If appellants do not file an amended brief during the one-month period, or file an amended brief which does not overcome all the reasons for non-compliance

Appeal No. 2003-0594
Application No. 09/479,267

stated in the notification, the appeal will stand dismissed. See 37 CFR § 1.192(d) (1997).

This application, by virtue of its "special" status, requires an immediate action, *MPEP* § 708.01 (D). It is important that the Board be promptly informed of any action affecting the appeal in this application.

REMANDED


BRADLEY R. GARRISS
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

THOMAS A. WALTZ
Administrative Patent Judge

TAW/jrg

Appeal No. 2003-0594
Application No. 09/479,267

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